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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,088	08/26/2003	Allan D. Morrison	87785.001	2771
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Intellectual Property Dept. Dewitt Ross & Stevens SC 2 East Mifflin Street Suite 600 Madison, WI 53703-2865				
EXAMINER				
SIEFKE, SAMUEL P				
ART UNIT		PAPER NUMBER		
1797				
NOTIFICATION DATE		DELIVERY MODE		
03/03/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket-ip@dewittross.com

Office Action Summary

Application No.

10/648,088

Applicant(s)

MORRISON, ALLAN D.

Examiner

SAM P. SIEFKE

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,8,11,12,15,16,18,28,30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,4,8,11,12,15,16,18,28,30 and 31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ ~~Notes of Informal Patent Application~~
- 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 8, 11, 12, 15, 16, 18, 28, 30 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Bargoot et al. (USPN 6,750,039).

Bargoot discloses a filtration apparatus that comprises a filter paper (4) that is placed in a recess (4) on a platform (1). The platform containing the filter paper is put into a container (fig. 3a). The filter when placed in the platform can be access on either side of the platform (1). The container in figure 3a and figure 9 both contain apertures 17 and 14 through which the filter when placed in the container can be accessed. The container further comprises a cover (24) to cap both apertures when the container is to be stored (fig. 6a-fig. 7). The container includes a locking mechanism (15) and a clamping mechanism that slides over around the container to secure the two halves together (fig. 3e). The platform may be completely or partially withdrawn from the container to enable access to the sample for processing. Claim 1 and 11 include the platform can be configured to be partially withdrawn from the container. The Examiner

maintains that the platform of Bargoot can be configured to be partially removed from the container. When the container is open, the platform can be partially placed or laid in order to be partially withdrawn or removed from the container. Regarding claim 12, and 28 the Examiner is interpreting the recess (4) as the indentation on the platform because it allows for the platform to be aligned when the platform is placed into the container because the apertures (14) and (17) line up and fit with the recess (4). Regarding the newly submitted amendments, the Examiner states that when the platform 1 is in an open position, the filter element exposed in that it can be moved around etc. When the platform is closed, it protects the filter element in that it cannot be removed and is in a stable state within the platform. The Examiner disagrees with the Applicant in that the platform cannot be considered a container. A container is something that can receive an object of interest. In this instant, the platform receives and holds the filter within the platform and maintains it therein.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 6, 7, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bargoot et al. (USPN 6,750,039) in view of Douglas et al. (USPN 6,818,180).

Bargoot teaches a filtration apparatus that comprises a filter paper (4) that is placed in a recess (4) on a platform (1).

Bargoot does not teach a barcode located inside the container

Douglas teaches a device that comprises a test strip that comprises a testing site and a barcode. The barcode provides control of the test instrument and calibration of the instrument (col. 17, lines 50-54). It would have been obvious to one having an ordinary skill in the art to modify Bargoot to employ a barcode in order to provide information to a sampling instrument and to also identify the sample test card.

Claims 2, 5, 9, 10, 14, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bargoot et al. (USPN 6,750,039) in view of Douglas et al. (USPN 5,872,713).

Bargoot teaches a filtration apparatus that comprises a filter paper (4) that is placed in a recess (4) on a platform (1).

Bargoot does not teach an electronic memory unit.

Douglas teaches an analytical testing device that comprise a test device 11 which is inserted into a optical detector 21 which optically detects a chemical reaction taking place. Douglas records the information on a ROM, RAM or EEPROMS (col. 8, lines 35-67) for storing purposes. Therefore it would have been obvious to one having an ordinary skill in the art to modify Bargoot to employ a electronic memory unit so that sample information may be recorded and then at a later time be interpreted and analyzed. Regarding claim 2, it would have been obvious to one having an ordinary skill in the art to modify Bargoot to employ a testing apparatus that is fully automated in which a mechanical extension is employed to withdraw the platform from the container. A fully automated apparatus is well known in the art and is crucial for processing hundreds or even thousands of samples. Regarding claim 5, it would have been obvious to one having an ordinary skill in the art to modify Bargoot to employ a lock and key type security access on the container to prevent tampering while in storage.

Response to Arguments

Applicant's arguments filed 2/19/10 have been fully considered but they are not persuasive. Regarding the newly submitted amendments, the Examiner states that when the platform 1 is in an open position, the filter element exposed in that it can be

moved around etc. When the platform is closed, it protects the filter element in that it cannot be removed and is in a stable state within the platform. The Examiner disagrees with the Applicant in that the platform cannot be considered a container. A container is something that can receive an object of interest. In this instant, the platform receives and holds the filter within the platform and maintains it therein.

The Examiner maintains that the platform of Bargoot can be configured to be partially removed from the container. When the container is open, the platform can be partially placed or laid in order to be partially withdrawn or removed from the container. Applicant argues, "As noted previously, independent claims 1 and 11 recite a system including a platform wherein the platform is configured to be "only" partially withdrawn from the container. Independent claim 28 includes a similar positive limitation. Claim 28 positively recites a system where the frame is "configured to be only partially withdrawn from said container." Independent claim 31 recites a cover "being adapted to remain in moveable connection to said frame." Regarding claims 1, 11, 28 and 31, these claims included intended use limitations, which do not further delineate the structure of the claimed apparatus from that of the prior art. Since these claims are drawn to an apparatus statutory class of invention, it is the structural limitations of the apparatus, as recited in the claims, which are considered in determining the patentability of the apparatus itself. These intended use limitations are accorded no patentable weight to an apparatus. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is

capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967); and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The Courts have held that it is well settled that the recitation of a new intended use, for an old product, does not make a claim to that old product patentable. See *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). The Courts have held that the manner of operating an apparatus does not differentiate an apparatus claim from the prior art, if the prior art apparatus teaches all of the structural limitations of the claim. See *Ex Parte Masham*, 2 USPQ2d 1647 (BPAI 1987) (see MPEP § 2114).

In short, each of the independent claims positively requires that the platform or cover be inseparable from the container or frame, respectively. The positive language of the claims is exclusionary. The word "only" as it appears in claims 1, 11, and 28 requires that the platform be present in one, and only one, condition: "partially withdrawn." A device such as Bargoot's, where the platform can be completely removed from the container, therefore does not fulfill the positive requirements of the claims. Therefore the rejection under 102(e) is improper and should be withdrawn. See the above arguments with respect to claim interpretation of "configured" in the claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAM P. SIEFKE whose telephone number is (571)272-1262. The examiner can normally be reached on M-F 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1700. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Samuel P Siefke/
Primary Examiner, Art Unit 1797